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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/814,365	03/31/2004	Omar Habib Khan	24207-10084	7766
62296	7590	10/02/2006	EXAMINER	
GOOGLE / FENWICK SILICON VALLEY CENTER 801 CALIFORNIA ST. MOUNTAIN VIEW, CA 94041			DAYE, CHELCIE L	
			ART UNIT	PAPER NUMBER
			2161	

DATE MAILED: 10/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/814,365

Applicant(s)

KHAN ET AL.

Examiner

Chelcie Daye

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>10/14/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is issued in response to Application filed March 31, 2004.
2. Claims 1-36 are pending.

Information Disclosure Statement

3. The information disclosure statement (IDS) submitted on 10/14/2004 was filed after the mailing date of the application on 3/31/2004. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claim 12 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 12 recites "identifying a plurality of named entities for a name by using.... middle name only". However, applicant does not describe anywhere within the

specification of this particular limitation and how the applicant ascertained the outcome. Therefore, in order to further prosecution, no art will be provided for this limitation.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

7. Claims 19 and 36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 19 and 36, the term "if" is a relative term, which renders the claims indefinite. The term "if" is considered alternative language, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Due to the language of the above stated claims, examiner is unsure of what the outcome would be if the statement were not applied. Therefore, the above stated claims will be examined without giving weight to the term "if". Further corrections needed.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

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only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1-7,10-11,and 20-27 are rejected under 35 U.S.C. 102(e) as being anticipated by Malik (US Patent No. 7,007,085) filed March 29, 2002.

Regarding Claims 1 and 20, Malik discloses a method comprising:

identifying an event associated with an article (column 9, lines 36-40,

Malik);

identifying a named entity within the event (column 9, lines 40-54, Malik);

and

creating an implicit search query comprising the named entity (columns 11-12, lines 64-67 and 1-8, respectively, Malik).

Regarding Claims 2 and 21, Malik discloses the method further comprising determining a list of named entities (column 8, lines 21-34, Malik).

Regarding Claims 3 and 22, Malik discloses the method wherein identifying the named entity within the event comprises identifying an entity in the event that matches an entity in the list of named entities (column 14, lines 33-53, Malik).

Regarding Claims 4 and 24, Malik discloses the method wherein determining the list of named entities comprises monitoring instant messaging traffic (column 8, lines 14-20, Malik).

Regarding Claims 5 and 25, Malik discloses the method wherein determining the list of named entities comprises analyzing an email data store (column 8, lines 14-20, Malik).

Regarding Claims 6 and 26, Malik discloses the method wherein determining the list of named entities comprises analyzing a directory structure (column 12, lines 44-61, Malik).

Regarding Claims 7 and 27, Malik discloses the method wherein determining the list of named entities comprises searching a contact list (column 12, lines 44-61, Malik).

Regarding Claim 10, Malik discloses the method wherein the named entity comprises one of an email address, an instant messaging name, and a proper noun (Fig.2; column 8, lines 14-34, Malik).

Regarding Claims 11 and 23, Malik discloses the method further comprising storing the named entity in a user profile (column 11, lines 38-63, Malik).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 8-9,12-19,and 28-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Malik (US Patent No. 7,007,085) filed March 29, 2002, in view of Maybury (US Patent No. 6,961,954) filed March 2, 1998.

Regarding Claims 8 and 28, Malik discloses all of the claimed subject matter as stated above. However, Malik is silent with respect to the list of named entities comprises searching a news list. On the other hand, Maybury discloses searching a news list (column 16, lines 48-50, Maybury). Malik and Maybury are analogous art because they are from the same field of endeavor of the management of information. It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate Maybury's teachings into the Malik system. A skilled artisan would have been motivated to combine as suggested by Maybury at column 2, lines 41-53, in order to automatically

summarize data representative of news information so that it may be visualized and searched in a manner which is compatible with popular browsing tools.

Regarding Claims 9 and 29, the combination of Malik in view of Maybury, disclose the method wherein determining the list of named entities comprises part of speech tagging (columns 10-11, liens 55-67 and 1-3, respectively, Maybury).

Regarding Claims 12 and 32, the combination of Malik in view of Maybury, disclose the method further comprising identifying a plurality of named entities for a name by using first name only, last name only, middle name only, and combinations thereof (Fig.18; column 18, lines 4-9, Maybury).

Regarding Claims 13 and 33, the combination of Malik in view of Maybury, disclose the method further comprising filtering out at least one of the plurality of named entities having a high document frequency (DF) (column 16, lines 50-57, Maybury).

Regarding Claims 14 and 34, the combination of Malik in view of Maybury, disclose the method further comprising associating a weight with a named entity (Fig.18; column 16, lines 3-13, Maybury).

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Regarding Claims 15 and 30, the combination of Malik in view of Maybury, disclose the method further comprising:

receiving a result set associated with the implicit query (column 17, lines 9-10, Malik); and

outputting the result set (Fig.17; column 17, lines 11-25, Malik).

Regarding Claims 16 and 31, the combination of Malik in view of Maybury, disclose the method further comprising:

receiving an interest signal associated with the named entity (column 16, lines 62-65, Maybury); and

ranking the result set based at least in part on the interest signal (column 16, lines 65-67, Maybury).

Regarding Claims 17 and 35, the combination of Malik in view of Maybury, disclose a method comprising:

identifying a named entity in a data store (column 9, lines 40-54, Malik);

and

determining a weight to associate with the named entity (Fig.18; column 16, lines 3-13, Maybury).

Regarding Claim 18, the combination of Malik in view of Maybury, disclose the method wherein the data store comprises one of an email data store (column

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8, lines 14-20, Malik), a directory structure, and a contact list (column 12, lines 44-61, Malik).

Regarding Claims 19 and 36, the combination of Malik in view of Maybury, disclose a method comprising:

receiving an event (column 9, lines 36-40, Malik);;

identifying a named entity in the event (column 9, lines 40-54, Malik);

creating an implicit query based at least in part on the named entity (columns 11-12, lines 64-67 and 1-8, respectively, Malik);

transmitting the implicit query to an index (); and

receiving a result set from the index, the result set comprising one or more article identifiers (column 14, lines 33-53, Malik); and outputting the one or more article identifiers if an associated score exceeds a threshold (column 19, lines 42-50, Malik).

Other Prior Art Made of Record

Cloutier et al. (US Patent No. 6,772,188) discloses a system and method for receiving an electronic communication containing an identifier or indicia of an entity and, in response to a user's selection of the identifier, initiating communication between the user and the entity.


Points of Contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chelcie Daye whose telephone number is 571-272-3891. The examiner can normally be reached on M-F, 7:00 - 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Gaffin can be reached on 571-272-4146. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Chelcie Daye
Patent Examiner
Technology Center 2100
September 25, 2006


Sana Al-Hashem